

Application No. 09/593,591
Amendment dated November 10, 2006
Reply to Office Action of June 7, 2006

REMARKS

Applicant amended claims 1, 2, 85, 163, 203, 223 and 263 to further define Applicant's invention. No new matter has been added.

In the Office Action, the Examiner objected to claim 2 based on informalities. Applicant amended claim 2 to correct the spelling of "mid-longitudinal" to overcome the objection.

The Examiner rejected claims 1, 2, 4, 5, 7-20, 22, 25, 30, 32-35, 85, 86, 88, 89, 91-106, 109, 114-119, 127-129, 148, 158, 163, 164, 171, 174, 175, 179, 180, 203, 204, 206, 208-211, 213-215, 219, 220, 223, 224, 226, 228-231, 233-235, 239, 240, 263, 264, 266, 268-271, 273-275, 279, and 280 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,277,149 to Boyle et al. ("Boyle") in view of U.S. Patent No. 5,865,845 to Thalgott ("Thalgott"); rejected claims 26-29, 110-113, 149-152, 155-157, 159-162, 172, 177, 178, 182, 212, 217, 218, 222, 232, 237, 238, 242, 272, 277, 278, and 282 under 35 U.S.C. § 103(a) as being unpatentable over Boyle and Thalgott as applied in the previous rejection, and further in view of U.S. Patent No. 5,397,364 to Kozak et al. ("Kozak"); rejected claims 36-42, 120-126, 166, 168-170, 173, 181, 206, 221, 241, and 281 under 35 U.S.C. § 103(a) as being unpatentable over Boyle in view of Thalgott as applied in the rejection of claim 1 above, and further in view of the suggestions of Boyle; and rejected claims 23, 24, 107, 108, 176, 196, 216, 236, 256, and 276 under 35 U.S.C. § 103(a) as being unpatentable over Boyle in view of U.S. Patent No. 5,669,909 to Zdeblick et al. ("Zdeblick").

Applicant amended independent claims 1, 85, 163, 203, 223 and 263 to delete the term "generally" and to recite that the "opening has a perimeter located closer to said leading end than said trailing end of said body" of the implant. Support for this amendment is found in the specification at least in Figs. 2A, 2B, and 10. No such structure is disclosed or suggested by Boyle or Thalgott either alone or when properly combined.

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Boyle teaches an implant having an opening that is equidistant from the leading and trailing ends. (See Boyle, Figs. 10, 11, 12.) Thalgott teaches an implant having an opening with a perimeter that is closer to the trailing end of the implant. (See Thalgott, Figs. 2, 6, and 8.)

Several advantages are offered by a bone ring implant having an opening that is coincident with the medullary canal and a perimeter that is closer to the leading end of the implant in accordance with the claimed invention. For example, such structure permits keeping the trailing end of the bone ring relatively intact and only cutting the straight portions of the leading end and exterior sides to form the implant. Such a configuration permits better utilization of the bone ring by leaving a significant portion of the bone ring intact proximate the trailing end of the implant. (See Specification, page 8, lines 5-17; page 9, line 17 to page 10, line 4; and Figs. 2A, 2B, and 10.)

Applicant submits that the rejections of independent claims 1, 85, 163, 203, 223, and 263 under 35 U.S.C. § 103(a) over Boyle in view of Thalgott has been overcome. Applicant submits that the rejections of claims 23, 24, 26-29, 36-42, 107, 108, 110-113, 120-126, 149-152, 155-157, 159-162, 166, 168-170, 172, 173, 176-178, 181, 182, 196, 206, 212, 216-218, 221, 222, 232, 236-238, 241, 242, 256, 272, 276-278, and 281 are rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom.

Applicant respectfully traverses the Examiner's rejection of claims 23, 24, 107, 108, 176, 196, 216, 236, 256, and 276 under 35 U.S.C. § 103(a) over Boyle in view of Zdeblick as being improper. Contrary to the Examiner's assertions, Boyle does not meet or render obvious the claim limitations. In order to meet the claim limitations of the independent claims from which claims 23, 24, 107, 108, 176, 196, 216, 236, 256, and 276 depend from, the Examiner combined Boyle with Thalgott. Yet, for the dependent claims, the Examiner uses Boyle alone. Applicant submits that the rejection of the claims under 35 U.S.C. § 103(a) over Boyle in view of Zdeblick does not present a prima facie case of obviousness.

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Applicant submits that independent claims 1, 43, 85, 163, 183, 203, 223, 243 and 263 are patentable and that dependent claims 2, 4, 5, 7-20, 22, 23, 24, 25, 26-29, 30, 32-35, 36-42, 86, 88, 89, 91-106, 107, 108, 109, 110-113, 114-119, 120-126, 127-129, 148, 149-152, 155-157, 158, 159-162, 164, 166, 168-173, 174, 175, 176, 177, 178, 179, 180, 181, 182, 196, 204, 206, 208-211, 212, 213-215, 216, 217, 218, 219, 220, 221, 222, 224, 226, 228-231, 232, 233-235, 236, 237, 238, 239, 240, 241, 242, 256, and, 264, 266, 268-271, 272, 273-275, 276, 277, 278, 279, 280 and 281 dependent from independent claim 1, 43, 85, 163, 183, 203, 223, 243 and 263, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.


In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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